

DEC 27 2005

PATENT

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Date:

12-27-05
Christina M. Padamonsky**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Joerg Schlieffers, *et al.*

Examiner: Diane I. Lee

Serial No: 09/835,733

Art Unit: 2876

Filing Date: April 16, 2001

Title: DATA ACQUISITION APPARATUS

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Appellants' representative submits this brief in connection with an appeal of the above identified application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [TELNP226USA].

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I. Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Symbol Technologies, Inc., the assignee of the present application.

II. Related Appeals and Interferences (37 C.F.R. § 41.37(c)(1)(ii))

Appellant, appellants' legal representatives, and/or the assignee of the present application are unaware of any appeals or interferences which will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims (37 C.F.R. § 41.37(c)(1)(iii))

Claims 1-13 have been cancelled and claims 14-38 stand rejected by the Examiner. The rejection of claims 14-38 is being appealed.

IV. Status of Amendments (37 C.F.R. § 41.37(c)(1)(iv))

Amendments to claims 14, 21, 35-38 were submitted after the Final Office Action but were not entered.

V. Summary of Claimed Subject Matter (37 C.F.R. § 41.37(c)(1)(v))**A. Independent Claim 14**

Independent claim 14 recites a hand-held optical scanning device. The device includes a body (12) including an upper surface having a display (24) mounted thereof. The device also includes a handle (14) that extends from a bottom surface of the body. The handle (14) being joined to the body (12) to cause the handle (14) to rest on a surface of a user's hand to facilitate stability and weight distribution. The display (24) having a horizontal configuration. The device also includes a microcomputer that provides a display option in accordance with the horizontal configuration to orient display information on the display (24) based at least in part upon whether a user selects a left hand or right hand display option. (*See e.g.*, pg. 3, ln. 18 – pg. 4, ln. 19 and FIG. 1).

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B. Independent Claim 21

Independent claim 21 recites a hand-held optical scanning device. The device includes a body (12) having an optical scanning module (20) arranged to scan objects in a direction outward from a first distal end. The body (12) including an upper surface having a display (24) mounted thereof. The device also includes a handle (14) that extends from a bottom surface of the body (12) at the first distal end to increase a viewing angle of the display (24). The handle (14) being joined to the body to support a proximal end of the bottom surface of the body (12) by resting the handle on a radial surface of a user's hand to provide support. (*See e.g.*, pg. 3, ln. 18 – pg. 4, ln. 19; FIG. 1 and FIG 6).

VI. Grounds of Rejection to be Reviewed (37 C.F.R. § 41.37(c)(1)(vi))

A. Whether Claims 21-24, 28, 29 and 32 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* (U.S. 5,335,170) in view of VanHorn, *et al.* (U.S. 5,736,726).

B. Whether Claims 14-17, 20 and 33 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Wakatsuki, *et al.* (U.S. 5,023,438).

C. Whether Claims 34 and 38 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Williamson, *et al.* (US 5,475,381).

D. Whether Claim 36 are unpatentable under 35 U.S.C. §103(a) over Petteruti *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.* and further in view of Williamson, *et al.*

E. Whether Claims 18 and 19 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* in view of VanHorn, *et al.* in view of Wakatsuki, *et al.* and further in view of Reynolds, *et al.* (U.S. 5,828,052).

F. Whether Claims 25-27, 30 and 31 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* as modified by VanHorn, *et al.* and further in view of Reynolds, *et al.*

G. Whether Claim 37 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* in view of VanHorn, *et al.* and further in view of Harden, *et al.* (U.S. 5,237,162).

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H. Whether Claim 35 are unpatentable under 35 U.S.C. §103(a) over Petteruti, *et al.* in view of VanHorn, *et al.*, in view of Wakatsuki *et al.* and further in view of Harden, *et al.*

VII. Argument (37 C.F.R. § 41.37(c)(1)(vii))

A. Rejection of Claims 21-24, 28, 29 and 32 Under 35 U.S.C. § 103(a)

Claims 21-24, 28, 29 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* (U.S. 5,335,170) in view of VanHorn, *et al.* (U.S. 5,736,726). It is respectfully submitted that this rejection should be reversed for at least the following reasons. Petteruti, *et al.* and VanHorn, *et al.*, alone or in combination, fail to teach or suggest each and every feature of the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). An examiner cannot establish obviousness by locating references which describe various aspects of a patent [applicant's] invention *without also providing evidence of the motivating force* which would impel one skilled in the art to do what the patent [applicant has] done. *Ex parte Levengod*, 28 USPQ2d 1300 (P.T.O.B.A.&I. 1993) (emphasis added).

The claimed invention relates to an optical scanning device, that provides a pistol configuration with an improved ergonomic arrangement. In particular independent claim 21 recites a hand-held optical scanning device, comprising a body having an optical scanning module arranged to scan objects in a direction outward from a first distal end, the body including an upper surface having a display mounted thereof, and a handle that extends from a bottom surface of the

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body at the first distal end to increase a viewing angle of the display, the handle being joined to the body *to support a proximal end of the bottom surface of the body by resting the handle on a radial surface of a user's hand to provide support*. Neither Petteruti, *et al.* nor VanHorn, *et al.*, alone or when combined, teach or suggest these novel features.

The Final Office Action dated July 27, 2005, concedes that Petteruti, *et al.* does not teach or suggest all the aspects of the subject claims, but incorrectly contends that VanHorn, *et al.* cures the deficiencies of Petteruti, *et al.* In particular, VanHorn, *et al.* does not teach or suggest the handle being joined to the body *to support a proximal end of the bottom surface of the body by resting the handle on a radial surface of a user's hand to provide support*, as afforded by independent claim 21. Rather, VanHorn *et al.* discloses a pistol configuration (See Abstract) that can be *grasped or gripped* by the operator's hand (See col. 5, lines 17-19), but is silent with respect to the body of the bar code *reader resting on the hand to provide support*. As an example to further illustrate this distinction, the pistol configuration of the reference shows an angle of approximately 13.4 degrees with respect to a line perpendicular to the base of the body. An angle of 13.4 degrees is insufficient to rotate or extend the radial surface of a user's hand in order to come into contact with the base while the handle is gripped. In contrast, the optical scanning device depicted in Fig. 1 of the subject invention, has an angle of approximately 36.3 degrees with respect to perpendicular to the body. This angle of the handle facilitates *resting of the handle on a radial surface of a user's hand* to provide support. In VanHorn, *et al.*, given the much smaller angle of the handle, the *handle can not touch, let alone rest* on the user's hand given the location of the handle grip in VanHorn *et al.*

Furthermore, assuming *arguendo* that the body of the pistol configuration taught by VanHorn *et al.* does *touch a radial surface of a user's hand*, it is readily apparent that it is not resting on a radial surface of a user's hand *to provide support*. Rather, in VanHorn, *et al.* it can be seen from Fig. 3 that if the scanner is rotated clockwise about the handle, the hand strap hinge 117 will *contact the user's wrist in the resting condition, not the radial surface of the user's hand as claimed* because the proximal end of the scanning device extends out well past the radial surface of the user's hand and the hand strap hinge 117 is the lowest point on the bottom of the scanner. Thus it is readily apparent that no situation exists where the pistol body taught by VanHorn *et al.* will touch the radial surface of the user's hand. Moreover, at page 4 of the Final

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Office Action, the Examiner suggests that the VanHorn *et al.* was made to incorporate a handle configuration in order to provide a pistol-like configuration of hand-held optical scanner, such that an operator may grip the pistol gripping portion of the handle like the hand of a pistol, which minimizes the fatigue associated with operating the hand-held optical scanner for an extended period of time. However, VanHorn, *et al.* actually teaches away from the pistol configuration being used over an extended period by suggesting the option of selecting between two different gripping configurations, *with and without the handle to avoid repetitive motions over a long period of time.* (See col. 3, lines 15-19).

For at least the foregoing reasons, it is readily apparent the Petteruti, *et al.*, individually or in combination with VanHorn, *et al.*, fails to teach or suggest all the claimed aspects of the subject invention. Accordingly, independent claim 21 (and claims 22-24, 28-29 and 32 depending therefrom) is believed to be in condition for allowance. Reversal of this rejection is respectfully requested.

B. Rejection of Claims 14-17, 20 and 33 Under 35 U.S.C. § 103(a)

Claims 14-17, 20 and 33 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 and further in view of Wakatsuki, *et al.* (U.S. 5,023,438). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Petteruti, *et al.*, VanHorn, *et al.* and Wakatsuki *et al.*, either alone or in combination, fail to teach or suggest all aspects recited in the subject claims.

Claims 15-17 and 20 depend from independent claim 14, and claim 33 depends from independent claim 21. As noted above with regard to independent claim 21 (which recites similar features as independent claim 14), Petteruti *et al.* and VanHorn *et al.* fail to teach or suggest supporting *the bottom surface of the body by resting the handle on a surface of a user's hand.* Wakatsuki, *et al.* does not make up for the aforementioned deficiencies of Petteruti, *et al.* and VanHorn, *et al.* Wakatsuki, *et al.* provides a portable pen-scanner type bar code reader, but does not contemplate a handle that rests on the surface of the hand, let alone any type of handle grip. Rather, Wakatsuki *et al.* requires a user to grasp the end of the scanning device between the user's fingers. (See abstract). Consequently, Wakatsuki, *et al.* is silent with respect

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to the handle being *joined to the body to cause the handle to rest on the surface of a user's hand to facilitate stability and weight distribution*, as in the claimed invention. Therefore for at least the foregoing reasons, it is readily apparent the Petteruti, *et al.* individually or in combination with VanHorn, *et al.* and Wakatsuki, *et al.* fails to teach or suggest all the claimed aspects of the subject invention. Accordingly, this rejection should be reversed.

C. Rejection of Claim 34 and 38 Under 35 U.S.C. §103(a)

Claims 34 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.* as applied to claim 21 and further in view of Williamson, *et al.* (US 5,475,381). Reversal of this rejection is respectfully requested for at least the following reasons. In view of the foregoing, it is readily apparent that the cited art does not teach or suggest each and every limitation set forth in the subject claims.

In particular, Williamson, *et al.* does not make up for the aforementioned deficiencies of VanHorn, *et al.* with respect to the independent claim 21, from which claims 34 and 38 depend. Williamson, *et al.* relates to a transmitter that generates an infrared signal that corresponds to a bit stream of binary data. Every binary signal created by the transmitter has a set of infrared pulses corresponding to one state of the binary signal and a second set of infrared pulses representing a second state of the binary signal. (See e.g., col. 1, lines 50-55). Williamson, *et al.* does not teach or disclose a handle being *joined to the body to cause the handle to rest on the surface of a user's hand to facilitate stability and weight distribution*. Thus, all claimed aspects as recited in independent claim 21 (and its dependent claims) are not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* in view of Williamson, *et al.* Accordingly, it is respectfully submitted that this rejection be reversed.

D. Rejection of Claim 36 Under 35 U.S.C. §103(a)

Claim 36 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.* as applied to claim 14 above, and further in view of Williamson, *et al.*

The rejection with respect to claim 36 (that depends from independent claim 14) should be reversed for at least the following reasons. As discussed *supra*, Wakatsuki, *et al.* does not cure

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the aforementioned deficiencies of Petteruti, *et al.* and VanHorn *et al.* with respect to claim 14 and Williamson *et al.* is silent with respect a handle being *joined to the body to cause the handle to rest on the surface of a user's hand to facilitate stability and weight distribution*. Thus, the combination of Petteruti, *et al.*, VanHorn, *et al.*, Williamson, *et al.* and Wakatsuki, *et al.* does not teach or suggest the aspects as recited in the subject claims. This rejection should be reversed.

E. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.* and Wakatsuki, *et al.*, as applied to claim 14 above, and further in view of Reynolds, *et al.* (U.S. 5,828,052). It is respectfully requested that this rejection be reversed for at least the following reasons.

Reynolds, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 14. Thus, the subject invention as recited in independent claim 14 (and claims 18 and 19 which depend from claim 14) is not obvious over Petteruti, *et al.*, VanHorn, *et al.*, Wakatsuki, *et al.* and in view of Reynolds, *et al.* Accordingly, this rejection should be reversed.

F. Rejection of Claims 25-27, 30 and 31 Under 35 U.S.C. § 103(a)

Claims 25-27, 30 and 31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 above, and further in view of Reynolds, *et al.*

Reversal of this rejection is hereby requested for at least the following reasons. Claims 25-27 and 30-31 depend from independent claim 21 and Reynolds, *et al.* does not cure the aforementioned deficiencies of VanHorn *et al.* with respect to independent claim 21. Therefore, the aspects of the subject invention as recited in independent claim 21 is not obvious over Petteruti, *et al.*, VanHorn, *et al.* and Reynolds, *et al.* Accordingly, reversal of this rejection is respectfully requested.

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G. Rejection of Claim 37 Under 35 U.S.C. § 103(a)

Claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, as applied to claim 21 above, and further in view of Harden, *et al.* (U.S. 5,237,162).

Reversal of this rejection is respectfully requested for at least the following reasons. Harden, *et al.* does not cure the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 21, from which claim 37 depends. Thus, the subject invention as recited in independent claim 21 is not obvious over Petteruti, *et al.* as modified by VanHorn, *et al.* and Harden, *et al.* Accordingly, this rejection should be reversed.

H. Rejection of Claim 35 Under 35 U.S.C. § 103(a)

Claim 35 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Petteruti, *et al.* as modified by VanHorn, *et al.*, Wakatsuki *et al.* as applied to claim 14, and further in view of Harden, *et al.*

Reversal of this rejection is respectfully requested for at least the following reasons. Claim 35 depends from independent claim 14. Harden, *et al.* does not make up for the aforementioned deficiencies of VanHorn *et al.* with respect to the independent claim 21. Thus, the subject invention as recited in independent claim 21 (and claim 35 depending therefrom) is not obvious over Petteruti, *et al.*, VanHorn, *et al.* and Hayden, *et al.* Therefore, reversal of this rejection is requested.

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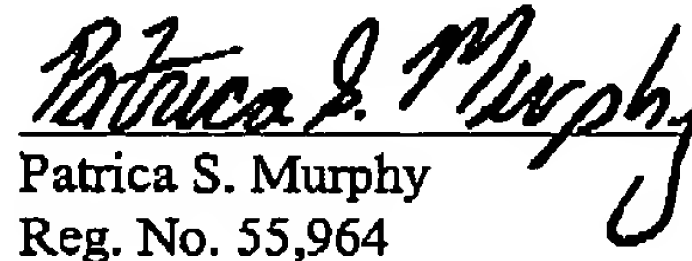
Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 14-34 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [TELNP226USA].

Respectfully submitted,

AMIN & TUROCY, LLP


Patrica S. Murphy
Reg. No. 55,964

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone: (216) 696-8730
Facsimile: (216) 696-8731

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VIII. Claims Appendix (37 C.F.R. § 41.37(c)(1)(viii))

1-13. (Cancelled).

14. A hand-held optical scanning device, comprising:

a body including an upper surface having a display mounted thereof;

a handle that extends from a bottom surface of the body, the handle being joined to the body to cause the handle to rest on a surface of a user's hand to facilitate stability and weight distribution, the display having a horizontal configuration; and

a microcomputer that provides a display option in accordance with the horizontal configuration to orient display information on the display based at least in part upon whether a user selects a left hand or right hand display option.

15. The hand-held optical scanning device of claim 14, the handle being integrally molded with the bottom of the body.

16. The hand-held optical scanning device of claim 14, comprising a wireless data transmission system for communicating data.

17. The hand-held optical scanning device of claim 16 being operative in a local area wireless network.

18. The hand-held optical scanning device of claim 14, the body including a lower housing member and an upper housing member that forms a cover, a resilient sealing member interposed between the lower housing member and cover to form a dust and moisture resistance seal therebetween.

19. The hand-held optical scanning device of claim 18, the cover including a digital display.

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20. The hand-held optical scanning device of claim 14, the display is configurable to adapt to a user's preference, the users preference including at least one of the horizontal configuration and a vertical configuration.
21. A hand-held optical scanning device, comprising:
a body having an optical scanning module arranged to scan objects in a direction outward from a first distal end, the body including an upper surface having a display mounted thereof; and
a handle that extends from a bottom surface of the body at the first distal end to increase a viewing angle of the display, the handle being joined to the body to support a proximal end of a bottom surface of the body by resting the handle on a radial surface of a user's hand to provide support.
22. The hand-held optical scanning device of claim 21, the handle including a trigger.
23. The hand-held optical scanning device of claim 22, the trigger being a two-finger trigger.
24. The hand-held optical scanning device of claim 22, the trigger facilitating at least one of the following functions: read only, read and store, and scroll menu utility.
25. The hand-held optical scanning device of claim 21, further comprising a resilient member between a lower body member and cover, the resilient member extending a distance beyond the lower body member and cover a substantial portion of a periphery of the body.
26. The hand-held optical scanning device of claim 25, the resilient member providing a bumping surface that protects the users hand.
27. The hand-held optical scanning device of claim 25, the resilient member providing a bumping surface that protects the device.

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28. The hand-held optical scanning device of claim 21, the handle being integrally molded with the bottom of the body.
29. The hand-held optical scanning device of claim 21, comprising a wireless data transmission system for communicating data.
30. The hand-held optical scanning device of claim 21, the body including a lower housing member and an upper housing member that forms a cover, a resilient sealing member interposed between the lower housing member and cover to form a dust and moisture resistance seal therebetween.
31. The hand-held optical scanning device of claim 30, the cover including a digital display.
32. The hand-held optical scanning device of claim 21, further comprising a display that is configurable to adapt to a user's preference.
33. The hand-held optical scanning device of claim 32, the display being configurable vertically and horizontally.
34. The hand-held optical scanning device of claim 32, the display being configurable to provide portrait and landscape views.
35. The hand-held optical scanning device of claim 14 wherein the bottom surface is a contoured bottom surface.
36. The hand-held optical scanning device of claim 14, wherein the display is a touch sensitive data entry display.
37. The hand-held optical scanning device of claim 21, wherein the bottom surface is a contoured bottom surface.

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38. The hand-held optical scanning device of claim 21, wherein the display is a touch sensitive data entry display.

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IX. Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))

None.

X. Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))

None.